

specification. Applicants believe that entry of this amendment overcomes Examiner's objection to the specification.

Objection to Claim 77

The Examiner objected to claim 77 because of the term, "wordstation," on the second line of the claim is not in proper form (i.e., a typographical error). Applicants have amended claim 77 to adopt the language suggested by the Examiner, namely, "workstation." The amendment to claim 77 clarifies the subject matter recited in the claim. Accordingly, claim 77 is now believed to be in condition for allowance.

Rejections Under 35 U.S.C. § 102 and 103

The Examiner rejected claims 74-76 under 35 U.S.C. § 102(e) as being anticipated by Wood et al. (U.S. Pat. No. 5,891,035). Further, the Examiner rejected claims 59-61, 64, 66, and 68 under 35 U.S.C. § 103(a) as being unpatentable over Wood et al. (U.S. Pat. No. 5,891,035) in view of Reeder et al. (U.S. Pat. No. 5,852,812). The Examiner rejected claims 62 and 63 under 35 U.S.C. § 103(a) as being unpatentable over Wood et al. (U.S. Pat. No. 5,891,035) in view of Reeder et al. (U.S. Pat. No. 5,852,812) and Wyman (U.S. Pat. No. 5,260,999). The Examiner rejected claims 65 and 67 under 35 U.S.C. § 103(a) as being unpatentable over Wood et al. (U.S. Pat. No. 5,891,035) in view of Reeder et al. (U.S. Pat. No. 5,852,812) and Clarke et al. (U.S. Pat. No. 5,982,917). Also, the Examiner rejected claims 69-73 under 35 U.S.C. § 103(a) as being unpatentable over Wood et al. (U.S. Pat. No. 5,891,035) in view of Reeder et al. (U.S. Pat. No. 5,852,812). The Examiner rejected claims 77 and 78 under 35 U.S.C. § 103(a) as being unpatentable over Wood et al. (U.S. Pat. No. 5,891,035).

The Applicants have amended independent claims 59, 69, and 74 to include the subject matter of claim 65 to clarify the subject matter recited in the claims. The

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burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

As each of the independent claims 59, 69, and 74 includes the recitations of claim 65, the claims will be discussed together with regard to the Examiner's rejection of claim 65, now cancelled. The Examiner rejected claims 65 and 67 under 35 U.S.C. § 103(a) as being unpatentable over Wood et al. (U.S. Pat. No. 5,891,035) in view of Reeder et al. (U.S. Pat. No. 5,852,812) and Clarke et al. (U.S. Pat. No. 5,982,917). The Applicants respectfully traverse this rejection.

Applicants have amended claims 59, 69, and 74 in the present response to more particularly recite that a user viewable indicia or a protocol list includes "an exemplary image obtainable via the protocol." The Wood et al., Reeder et al., and Clarke et al.

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references, alone or in the proposed combination, fail to teach or render obvious at least this feature. In fact, the Examiner admitted that the Wood et al. reference does not disclose that the user viewable indicia include an exemplary image obtainable via the protocol. Indeed, the Wood et al. reference is merely an ultrasound diagnostic imaging system with communication capability. The reference is absolutely devoid of any teaching of "an exemplary image obtainable via the protocol," as recited in the claims. Furthermore, the Reeder et al. reference is also devoid of this claimed element. In fact, the Reeder et al. reference is directed to an online billing system for exchanging international currency from credit card transactions. Reeder et al., col. 2, lines 36-44. Indeed, the reference is solely a billing system and does not even disclose a *protocol*, much less "an exemplary image obtainable via a protocol." Accordingly, the Reeder et al. and Wood et al. references do not render the independent claims obvious.

While the Examiner relies on Clarke et al. to disclose "an exemplary image obtainable via a protocol," the reference does not cure the deficiencies of the Reeder et al. and Wood et al. references, as discussed above, and Applicants submit that the reference has simply been misinterpreted. Applicants have carefully reviewed the Clarke et al. reference, but the reference is believed to be absolutely devoid of any teaching or suggestion of a *user viewable indicia* or a *protocol list* that includes "an exemplary image obtainable via the protocol." The Clarke et al. reference relates to a method for analyzing mammography images with computer software. Clarke et al., col. 4, lines 11-14. In fact, the reference teaches applying CAD modules to raw X-ray data to examine suspicious masses. Clarke et al., col. 6, lines 41-49.

Indeed, the Clarke et al. reference does not even disclose a *protocol*, much less "an exemplary image obtainable via a protocol," because the reference simply receives an X-ray image and manipulates the image. In addition to not disclosing a *protocol*, the reference clearly uses the figures in the reference to illustrate different stages of the CAD processing, not to associate "an exemplary image obtainable via a protocol," as recited in the claim.

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Clarke et al., col. 18, lines 24-27. On this point, the reference made to the figures simply misinterprets them. These images are not displayed to a user in connection with a protocol that can be selected from a list. Thus, the reference cannot render obvious the claimed subject matter because it fails to disclose claimed elements. Accordingly, the Wood et al., the Reeder et al., and the Clarke et al. references, alone or in the proposed combination, fail to render obvious *at least* the claimed element of “an exemplary image obtainable via a protocol.”

Accordingly, the cited reference fails to disclose *all* of the elements of the instant claims. Because the Examiner has failed to show that the cited reference discloses *all* of the claimed elements, the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, independent claims 59, 69, 74, and the respective dependent claims 60-64, 66-68, 70-73, and 75-78 are believed to be patentable over Wood et al., Reeder et al., and Clarke et al.

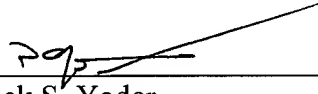
Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Attached hereto is a marked-up version of the changes made to the drawings and claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

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Respectfully submitted,



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